

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 10/595,037

REMARKS

Foreign Priority

Examiner Kavanaugh did not acknowledge either Applicant's claimed foreign priority date of July 10, 2003 for Belgium Appln. No. 2003/0399, or receipt of the certified priority document. (If the Examiner still has not received the certified priority document, he is asked to call Mr. Paul Bell in the PCT Legal Branch at 571-272-3278, who will forward the priority document to the Examiner.

Information Disclosure Statement

Apparently, the International Office (WIPO) did not forward to the USPTO the document CA 2246463 cited in the International Search Report. Thus, Applicant now encloses a copy of CA '463 and requests the Examiner to indicate his consideration thereof. It is noted that this document was cited in only Category A in the ISR. **Please charge any fee necessary for consideration of this reference to Deposit Account No. 19-4880.**

Claim Rejections - 35 U.S.C. § 112

Applicant cancels claims 23 and 24 without prejudice, thereby overcoming their rejection under 35 U.S.C. § 112, first paragraph.

Claim Rejections - 35 U.S.C. § 102

(1) Claims 13, 21, 22, 23 and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 2,175,962 (Kenifick).

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(2) Claims 13-16, 18, 21 and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,042,119 (Williams).

(3) Claims 13, 14, 15 and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 6,338,186 (Kleinmann).

These three rejections under 35 U.S.C. §102(b) require that the applied references disclose, either expressly or inherently, each limitation of each rejected claim, or in other words, that each rejected claim be **readable** on the applied reference. Applicant respectfully submits that clearly such is **not** the case here.

First, claim 1 has been amended to recite “a central part” which is supported in Applicant’s specification for example at page 11, lines 1-9.

US 2175962 (Kenifick) teaches a device covering the knot of the lace of a shoe.

The device of Kenifick does not have a “left-hand end and a right-hand end, each comprising mutual fixing means” but, rather, upper and lower ends.

The device according to Kenifick is not designed to be folded down in the closed position by fixing the left-hand end to the right-hand end.

Kenifick fails to disclose that the length of said device is “perpendicular to an axial direction of said shoe, when said device is placed” thereon.

The device is moreover not designed to “only partially cover” the loops but, rather, to clamp the knot.

Therefore, claim 1 is novel over US 2,175,962 (Kenifick).

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Williams (US 5,042,119) teaches a device that is not “in the form of a band in an open position” but, rather, in the form of a pocket,

The device according to Williams is provided for completely containing the tied lace, i.e., the loops, the free ends and the knot; further, the length of the device is not “perpendicular to the axial direction of” the shoe.

Hence, new claim 1 also is novel over Williams (US 5,042,119).

Kleinmann (US 6,338,186) teaches a circular device (see Fig. 5 and Fig. 6) that is not “in the form of a band”.

The device of Kleinmann also does not have “a central part comprising a series of orifices for the lace to pass through” (it is the left-hand end that has the orifices).

Therefore, claim 1 is clearly novel over Kleinmann.

The problem to be solved by the claimed invention is to provide more freedom of foot movement for the wearer of the device without causing rigidity, while being small, easy to manufacture and to place, and which can be adapted on all shoes for all feet.

The device according to the invention is folded back in closed position by attaching the left-hand side on the right-hand side around the loops of the lace and transversely with respect to the axial direction of the shoe. This operation is a very easy closing operation that can be done even by a child or a unhandy person.

For the device according to Kenifick, the user has to fold a top end on a bottom end without seeing anything he does.

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The device according to the invention, by providing a device that only partially covers the loops of the lace, does not confer rigidity to the device, and the transversal closing with respect to the loop in the axial direction of the shoe clearly renders easier the closing step.

Moreover, the device according to the invention stays in place when the shoe is removed and reduces the risk of losing it and should not need to be replaced each time the shoe is worn. Indeed, due to the fact that the device covers only the loops of the lace, it can be placed anywhere on the front side of the shoe, fixed between the lace and the eyelet of the shoe and provide some flexibility for the placement as compared to the device according to Kenifick.

The device according to Kenifick, due to the presence of a hole adapted to receive the knot of the lace, cannot be placed anywhere on the upper part of the shoe; and it seems that the device can be placed on the shoe only when the wearer knots the lace. Indeed, you must make a first knot, place the device on the knot, pass the lace through the orifice and paying attention not to drop the device during the passing of the lace and after, make the loop of the knot before the closing of the device. Hence, each time the wearer removes the shoe, he should pay attention to not lose the device, and each time he wishes to wear the device, he has to place it one more time.

Hence, the device according to Kenifick is very difficult to place, and should be replaced each time the wearer remove his shoe, in addition to the non-flexibility in view of the location of the placement on the shoe, the risk of loss, etc.

The device according to Applicant's invention is easy to place when you remove the shoe since it is placed downstream of the knot (see for example Fig. 4) and can be placed anywhere on

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the top or on the bottom, at the left-hand side or at the right-hand side on the central strip of the shoe (see Figs. 4 and 5).

Moreover, when the man skilled in the art is confronted with the problem of solving the difficulties for placing the device on the shoe and of allowing the device to stay in place, even when the shoe is removed to avoid the risk of loss and to avoid to have to replace the device on the shoe, while remaining a device easy to manufacture and not expensive, he will not find any teaching either in Kenifick or in any other reference to modify Kenifick to obtain the device of the claimed invention that presents all the aforesaid advantages.

For the Williams device, the user has to place the pocket on the upper portion of the shoe. This step is not really easy because the lace has to be passed through several orifices concomitantly.

The technical objective problem of the invention is the same as aforementioned and is to provide a device for preventing the lace coming undone that provides more freedom of foot movement for the wearer of the device without causing rigidity while being easy to place, easy to manufacture and not expensive.

The Williams device does not solve this technical problem because it causes a strong rigidity to the foot while being not easy to place, not easy to manufacture and not cheap.

The device according to Kleinmann, even if nearer to the one of the invention, is not easy to close. Indeed, according to Kleinmann, the loops should be placed within the first curved part of the device before closing the device. As it can be seen from Fig. 11 of this document, the

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placing of the loops in the device before closing will not be very easy and can surely not be done by a child. Moreover, when the device has to be closed, the user should maintain the loops within the first portion and find the closure system which is very small and precise. Therefore, the user should have a good look at this, but his hand for maintaining the loop will prevent a good vision for the closure.

In **contrast**, the device according to the claimed invention is in the form of a band allowing the user to fold down the left-hand end to the right-hand end and obtain overlapped left-hand and right hand-ends. The closing is clearly easier due to the flexible character of the band and to the fact that the orifices are present on a “central part” which allows a good line of vision for closure. Moreover, the device according to Kleinmann has a perimeter in closed position that is equal to the perimeter in open position.

According to the claimed invention, because the ends are overlapping ends, the perimeter in closed position is shorter than the perimeter in open position, thereby rendering the closing of the device easier and adapted for everybody.

Thus, as explained above, neither Kenifick, Williams nor Kleinmann teaches, or even suggests, all of the limitations of independent claim 13, whereby the claims rejected under 35 U.S.C. § 102(b) clearly are **not readable** on the applied reference(s), and therefore are **incapable** of being anticipated by the applied reference(s).

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Claim Rejections - 35 U.S.C. § 103

(4) Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either references: Williams '119 and Kleinmann '186.

(5) Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either reference: Kleinmann '186 and Kenifick '962.

Applicant also respectfully **traverses** these rejections under 35 U.S.C. § 103(a).

As explained above, Williams and Kleinmann, taken alone or in combination, do not teach, or even suggest, **all the limitations** of the independent parent claim 13, whereby Applicant respectfully submits that the teachings of Williams, Kleinmann and Kenifick, taken in any combination, are **incapable** of rendering obvious the subject matter of either of the dependent claims 17 and 19.

Therefore, Applicant also respectfully requests the Examiner to reconsider and withdraw the two rejections under 35 U.S.C. § 103(a).

In summary, then, and for the reasons presented above, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 112, 102 and 103, and to find the application to be in condition for allowance with all of claims 13-22 and 25; however, if for any reason the Examiner feels that the application is not now in condition for allowance, Examiner Kavanaugh is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application. (The Examiner will note that the "shoe" is a claimed element in claims 22 and 25).

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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